

REMARKS / ARGUMENTS

A. General

The application still contains 68 claims, notably claims 48 and 50-116.

No amendments are being made to the application by the present communication.

B. Summary of Rejection and Reply

In the present Office Action, the Examiner rejects claims 48 and 50-116 under 35 USC 103(a) as being unpatentable over U.S. Patent number 6,826,542 (hereinafter Virgin *et al.*) in view of U.S. Patent Application Publication No. US 2003/0167229 (hereinafter Ludwig *et al.*).

The Examiner previously relied upon Ludwig *et al.* to reject the claims of the present application in the Office Actions dated February 2, 2007 and July 17, 2007. In response to these previous rejections, on May 1, 2007 and January 17, 2008, the Applicant filed Affidavits to submit evidence predating the Ludwig *et al.* reference.

On page 10 of the present Office Action, the Examiner acknowledged receipt of the Affidavits submitted on May 1, 2007 and January 17, 2008 but indicated that these Affidavits were deficient for not establishing diligence from the time of the prior art reference date (April 3, 2001) and the filing of the present patent application (April 30, 2001). In particular, the Examiner indicated that the Affidavits did not provide an account of affirmative acts or acceptable excuses for that period of time. In light of the aforementioned alleged deficiency, the Examiner has continued to rely on Ludwig *et al.*, in combination with Virgin *et al.*, to reject the claims of the present application.

The present Office Action is silent on whether conception of the claimed invention prior to April 3, 2001 has been established to the Examiner's satisfaction. However, since the Examiner is now requesting evidence pertaining to diligence between the date of the reference and the filing of the present application, the Applicant understands that the Examiner considers that conception of the claimed invention prior to April 3, 2001 has been established.

In order to address the alleged deficiency pointed out by the Examiner, the Applicant has prepared and encloses herewith the following:

- A second Supplemental Affidavit executed by Mrs. Brigitte Mattar, a Canadian patent agent with the law firm of Smart & Biggar/Fetherstonhaugh providing evidence in support of establishing diligence between April 3, 2001 and April 30, 2001.

The Applicant submits that the above mentioned second Supplemental Affidavit, in combination with the Affidavits submitted with the communications filed on May 1, 2007 and January 17, 2008, establishes that conception of the subject matter in the independent claims took place prior to April 3, 2001 and that this conception was followed by diligence between April 3, 2001 and the filing of the application on April 30, 2001.

As can be seen with reference to the second Supplemental Affidavit, the present patent application was prepared primarily by Mrs. Mattar. The exhibits attached to this Affidavit provide evidence that, during the critical period between April 3, 2001 and April 30, 2001, continuous work was made either in connection with the present patent application, or in connection with related U.S. patent application no. 09/845,380.

When examining the enclosed second Supplemental Affidavit, the Applicant would like to bring to the Examiner's attention the following:

- At the time of the invention, the inventors of the present application were employed by Canadian National Railway Company (hereinafter referred to as "CN"), the assignee of the present application. CN employs a large number of people located in several cities in Canada and the United States (amongst other countries). In order to co-ordinate communications between Mrs. Mattar and inventors for patent applications pertaining to invoice processing, a central point of contact was designated, namely Mrs. Jennifer Marvin. At the time, Mrs. Jennifer Marvin was an employee of CN but was not an inventor for the present patent application. Since communications between Mrs. Mattar and the inventors for the present patent application was made through the intermediary of Mrs. Jennifer Marvin, a (non-inventor), rather than directly with the inventors, some delay for the co-ordination of communication between the inventors and the patent agent would be expected.
- As can also be seen in the second Supplemental Affidavit attached hereto, during the critical period between April 3, 2001 and April 30, 2001, Mrs. Mattar was working on at least one case related to the present patent application, namely patent application no. 09/845,380 (now abandoned). In *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986), the court recognized that reasonable diligence is established if the attorney worked reasonably hard on the application during the continuous critical period and that work on a related case(s) that contributes substantially to the ultimate preparation of an application can be credited as diligence. *Bey v. Kollonitsch* (*supra*) also recognized that inventors should not be penalized because his attorney reasonably prepared related applications together, thereby expediting filing of applications and prompt disclosure to the public of closely related inventions. Mrs. Mattar worked on U.S. patent application no. 09/845,380 and the present application together because the two pertained to related technology. The Applicant submits that U.S. patent application no. 09/845,380 and the present U.S. patent application are related and that work on one application contributed substantially to the ultimate preparation of the other application. In support of the Applicant's position that U.S. patent application no. 09/845,380 and the present U.S. patent application are related to one-another, the Applicant would like to point out the following:

- a) There is overlap between the disclosure of U.S. patent application no. 09/845,380 and that of the present application.
- b) Both patent applications were filed on the same day (April 30, 2001).
- c) The individuals listed as inventors in U.S. patent application no. 09/845,380 are the same as those listed in the present application.
- d) Communications pertaining to the subject matter described in U.S. patent application no. 09/845,380 and the present patent application were made jointly. In support of the above statement, the Examiner is invited to consider Exhibit "D" of the Affidavit submitted May 1, 2007 signed by the inventors and Exhibits "M10" and "M12" of the Supplemental Affidavit submitted concurrently with the present response.

Therefore, the Applicant submits that the work performed in connection with U.S. patent application no. 09/845,380 should be credited as diligence in connection with the present patent application.

In light of the above, the Applicant submits that conception of the invention prior to April 3, 2001 was followed by diligence between April 3, 2001 and the filing of the application on April 30, 2001. Consequently, the Applicant respectfully submits that Ludwig *et al.* is not citable against the claims of the present application.

In light of the foregoing, since Virgin *et al.* alone does not support a rejection of any of the independent claims 48, 72, 97, 113 and 116, the Applicant respectfully submits that the subject matter of these independent claims is novel and non-obvious and, as such, that these claims are in full condition for allowance.

Claims 50-71, 73-96, 98-112 and 114-115 depend either directly or indirectly from one of claims 48, 72, 97, 113 and 116, which have already been shown to be in condition for allowance. As

such, the Applicant respectfully submits that claims 50-71, 73-96, 98-112 and 114-115 are also novel, non-obvious and in condition for allowance.

CONCLUSION

In view of the above, it is submitted that claims 48 and 50-116 are in condition for allowance. Reconsideration of the rejections is requested. Allowance of claims 48 and 50-116 at an early date is solicited.

If the application is not considered to be in full condition for allowance, for any reason, the Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

Date: June 18, 2008

/BBG/
Bobby B. Gillenwater
Registration No. 31,105

BARNES & THORNBURG LLP
600 One Summit Square
Fort Wayne, Indiana 46802
U.S.A.
(260) 423-9440

encl.: Supplemental Affidavit